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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,386	02/12/2002	Charles W. Finkl	Finkl162cipD1	6098

7590

08/28/2003

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EXAMINER

IP, SIKYIN

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

**OFFICE ACTION SUMMARY**

☒ Responsive to communication(s) filed on 2/12/02

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) 18-28 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 18-28 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

**-SEE OFFICE ACTION ON THE FOLLOWING PAGES-**

## DETAILED ACTION

### *Response to Amendment*

1. The new claims 33-43 filed on February 12, 2002 have been renumbered to 18-28 respectively because there are only 17 claims in the original disclosure.

### *Oath/Declaration*

2. A new oath or declaration is required because in the second inventor box, the wordings in the second line of mailing address have been crossed out. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a

patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

4. A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

5. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 18-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6398885 to Finkl et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed processing steps overlap the steps of cited patent.

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 18, 19, 25, and 26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by USP 4280566 to Breen (col. 3, lines 15-29), USP 4693698 to Olson, II (col. 5, lines 3-7), or USP 4729274 to Marbach (col. 3, lines 29-38). The instant claimed mounting portion reads on the softer portion of cited references.

*Claim Rejections - 35 USC § 103*

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 18-28 are rejected under 35 U.S.C. § 103 as being unpatentable over prior art admission in view of SU 0817079, JP60-36621, SU 461956, SU 505719, or SU 802383 (references cited in parent application).

12. Prior art admission in instant specification, paragraph bridging pages 1-2 to first full paragraph of page 2 discloses the claimed heat treatment except for the claimed induction/infrared tempering step. However, SU 0817079, JP60-36621, SU 461956, SU 505719, and SU 802383 in their respective abstracts show that tempering with induction heating means are equivalently known in the art of cited references for heat treatment. Therefore, because these tempering means (salt bath heating and induction/infrared heating) were art-recognized at the time the invention was made, one of ordinary skill in the art would have found it obvious to replace salt bath tempering with induction/infrared tempering. With respect to the limitations in instant dependent claims for induction heating, such limitations would have been simply known as conventional to the artisan in the metallurgical art at the time the invention was made and/or were common practices which were so well known in the art that they would have been taken it for granted. Listing of common features or limitations of an otherwise known is not considered patentable under 35 U.S.C. § 103. See *In re Venner*, 120 USPQ 193 (CCPA 1958) and *In re LaVerne, et al.*, 108 USPQ 335.

13. With respect to the infrared heating that using different conventional heating means for the same method step is contemplated within ambit of ordinary skill artisan which is parallel to use same reactant in different form. See *In re Austin*, et al. 149 USPQ 685, 688.

14. Claims 21-24 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4280566 to Breen (col. 3, lines 15-29), USP 4693698 to Olson, II (col. 5, lines 3-7), or USP 4729274 to Marbach (col. 3, lines 29-38 as applied to claims 18-19 and 25-26.

15. The claimed subject matter as is disclosed and rejected above by the cited reference(s) except for the infrared radiation. But using different conventional heating means such as infrared radiation for the same method step is contemplated within ambit of ordinary skill artisan which is parallel to use same reactant in different form. See *In re Austin*, et al. 149 USPQ 685, 688.

16. Furthermore, it is well settled that method or process is an act or a series of acts and from the standpoint of patentability must distinguish over prior art in terms of steps. *Ex parte Forsyth and Hancher*, 151 USPQ 55, 55.

#### *Conclusion*

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121.

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Art Unit: 1742

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*Examiner Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

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SIKYIN IP  
PRIMARY EXAMINER  
ART UNIT 1742

S. Ip  
July 27, 2003